

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF VIRGINIA  
ALEXANDRIA DIVISION**

FILED

2015 DEC 22 P 2:49

CLERK US DISTRICT COURT  
ALEXANDRIA, VIRGINIA

SIRONA DENTAL SYSTEMS, INC.,  
30-30 47th Avenue, Suite 500  
Long Island City, New York,

and

DENTSPLY INTERNATIONAL INC.,  
221 West Philadelphia Street  
York, Pennsylvania

Civil Action No.

1:15CV1679  
AJT/JFA

Plaintiffs,

v.

IN RE DENTSPLY SIRONA.COM, an  
internet domain name

Defendant.

**COMPLAINT**

Plaintiffs, Sirona Dental Systems, Inc. ("Sirona Dental") and Dentsply International Inc. ("Dentsply") (collectively "Dentsply Sirona" or "Plaintiffs"), by their undersigned counsel, hereby file this Complaint, averring as follows:

**NATURE OF ACTION**

1. This is an action *in rem* brought under the Anticybersquatting Consumer Protection Act ("ACPA"), 15 U.S.C. § 1125(d), directed to the Internet domain name <dentsplysirona.com>.
2. The domain name <dentsplysirona.com> is currently registered to an unknown entity. The WHOIS record for the domain name identifies the current registrant as

“dentsplysirona.com” with a mailing address in Korea, at 17th fl, Specialty Construction Center, 395-70, Sindaebang-dong, Dongjak-gu, Seoul, KOREA 135-080 KR.

3. The registrar is identified as Hangang Systems, Inc., D/B/A doregi.com (“Hangang”), also of South Korea.

4. Pursuant to the ACPA, Plaintiff seeks an order compelling the owner of the <dentsplysirona.com> domain name registry, Verisign, Inc. (“Verisign”), to transfer the domain name <dentsplysirona.com> to a registrar of Plaintiffs’ choosing.

### **THE PARTIES**

5. Plaintiff Sirona Dental is a corporation organized and existing under the laws of the State of Delaware with a principal place of business at 30-30 47th Avenue, Suite 500 Long Island City, New York.

6. Plaintiff Dentsply is a corporation organized and existing under the laws of the State of Delaware with a principal place of business at 221 West Philadelphia Street York, Pennsylvania.

7. Dentsply and Sirona Dental have announced that their respective Boards of Directors have unanimously approved a definitive merger agreement under which the companies will combine in an all-stock merger of equals and that the name to be used by the merged company will be Dentsply Sirona.

8. Upon information and belief, “dentsplysirona.com” is listed as the current registrant of the domain name <dentsplysirona.com>, and is located at 17th fl, Specialty Construction Center, 395-70, Sindaebang-dong, Dongjak-gu, Seoul, KOREA 135-080 KR.

9. Upon information and belief, the domain name <dentsplysirona.com> was registered after the Plaintiffs' merger and the use of Dentsply Sirona as the corporate name was announced.

10. Upon information and belief, Hangang is the current domain name registrar holding the <dentsplysirona.com> domain name. Hangang is a Korean company with a principal address at 17th Floor, Specialty Construction Center 395-70 Sindaebang-dong Dongjak-gu Seoul 156-010 South Korea.

11. Upon information and belief, Hangang is a Korean domain name registrar with a Registrar Accreditation Agreement ("RAA") with the Internet Corporation for Assigned Names and Numbers ("ICANN").

12. The registry for the <dentsplysirona.com> domain name is Verisign, Inc. located at 12061 Bluemont Way, Reston, VA 20190.

### **JURISDICTION AND VENUE**

13. Plaintiffs herein assert a cause of action arising under federal law, the Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d), and this Court therefore has subject matter jurisdiction over this federal cause of action pursuant to 28 U.S.C. § 1331.

14. Verisign, Inc. is the exclusive registry of domain names in the ".com" top-level domain, and Verisign's principal place of business is in Reston, Virginia, within this district. This Court may therefore assert *in rem* jurisdiction under 15 U.S.C. § 1125(d)(2) given that Verisign, the domain name registry for <dentsplysirona.com>, is located in the Eastern District of Virginia.

15. Consistent with the requirements of 15 U.S.C. § 1125(d)(2)(A)(i), the domain name <dentsplysirona.com> as currently registered with Hangang violates Plaintiffs' rights in

their marks, which are registered in the U.S. Patent and Trademark Office and are protected under 15 U.S.C. § 1125(a), as well as the combined marks that are currently pending.

16. Consistent with the requirements of 15 U.S.C. § 1125(d)(2)(A)(ii)(I), Plaintiffs are not able to obtain *in personam* jurisdiction over any person who would have been a defendant in a civil action under 15 U.S.C. § 1125(d)(1) with respect to the domain name <dentsplysirona.com> because upon information and belief, the registrant (and the registrar) are located in South Korea with insufficient contacts in the United States that would subject them to personal jurisdiction in this or any other court in the United States.

17. Pursuant to 15 U.S.C. § 1125(d)(2)(A)(ii)(II)(aa), Plaintiffs have sent notice of this violation and intent to proceed under this paragraph to the registrant of the domain name at the postal and email addresses provided by the registrant to the registrar.

18. Consistent with the requirements of 15 U.S.C. § 1125(d)(2)(A)(ii)(II)(bb), Plaintiffs will publish notice of this action as the Court may direct promptly after filing the action.

19. Venue is proper in this district under 15 U.S.C. § 1125(d)(2)(A) because the registry for the <dentsplysirona.com> domain name, Verisign, is located in the Eastern District of Virginia and because the provision's other requirements have been met as set forth above.

#### **THE EVENTS GIVING RISE TO THE PLAINTIFFS' CLAIM**

20. Dentsply dates its history to 1899, and is one of the world's largest designers, developers, manufacturers and marketers of a broad range of consumable dental products for the professional dental market. Dentsply also manufactures and markets other consumable medical device products, but the principal product categories are dental consumable products, dental laboratory products, dental specialty products and consumable medical device products.

21. Dentsply conducts its business in the United States of America, as well as in over 120 foreign countries.

22. Both Dentsply and Sirona own marks covering their respective names.

23. Pursuant to 15 U.S.C. § 1115, the U.S. trademark registrations serve as prima facie evidence of the validity and registration of the registered marks, of Plaintiffs' ownership of the registered marks, and of Plaintiffs' exclusive right to use the registered marks in commerce on or in connection with the goods and services identified in the registrations.

24. Dentsply owns the following registrations for the mark DENTSPLY: U.S. Reg. Nos. 42,060; 565,182; 745,903; 1,165,378; 1,189,707; 1,209,417, and 2,478,818.

25. The DENTSPLY mark has been in use since 1902, and has been a registered mark since 1904.

26. The DENTSPLY mark is both distinctive and famous.

27. Sirona Dental dates back to the establishment of Reiniger, Gebbert & Schall, which introduced the first dental electrical drill in 1882. In 1925, the company became part of Siemens & Halske Group and in 1934 launched the smallest x-ray in the world, enabling dental x-rays for the first time.

28. In 1956, Siemens introduced Sirona as a brand for treatment centers, and in 1958 the group developed the first ball-bearing turbine for dental drills.

29. Sirona Dental is a leading global manufacturer of high quality, technologically-advanced dental equipment, and is focused on developing, manufacturing, and marketing innovative solutions for dentists around the world.

30. Sirona Dental's primary sources of revenue are its manufacture and sale of dental equipment. Sirona Dental also provides sales and after-sales service support to dentists and distributors through our growing sales and service infrastructure.

31. Sirona Dental Systems GmbH, a German subsidiary of Sirona Dental, owns the following registrations: U.S. Reg. No. 986,513 for the mark SIRONA, and U.S. Reg. No. 2,418,649 for the mark SIRONA THE DENTAL COMPANY.

32. The SIRONA mark was first registered in 1974 and has been in use since 1956.

33. The SIRONA mark is both distinctive and famous.

34. On September 15, 2015, Dentsply and Sirona Dental announced that their respective Boards of Directors had unanimously approved a definitive merger agreement under which the companies will combine in an all-stock merger of equals.

35. The announcement noted that "combined company will be called DENTSPLY SIRONA."

36. The announcement further provided that the "transaction will result in the world's largest manufacturer of professional dental products and technologies with an implied pro forma equity value of approximately \$13.3 billion, based on the closing prices of DENTSPLY and Sirona on September 14, 2015." The approximated yearly revenue of the combined company is \$3.8 billion.

37. Dentsply Sirona will be able to meet the needs of dental professionals all over the world and advance patient care.

38. Dentsply Sirona, supported by its leading platforms in consumables, equipment and technology, will offer a powerful set of complementary offerings and end-to-end solutions to enhance patient care. Dental professionals across the globe will be supported by the largest sales

and service infrastructure in the industry, supported by leading distributors, to deliver an optimized product range that will meet the increasing global demand for digital dentistry and integrated solutions.

39. On the day after the merger was announced, September 15, 2015, Sirona Dental applied for the following marks at the U.S. Patent and Trademark Office: Serial No. 86/757,796 for DENTSPLY & SIRONA: THE DENTAL SOLUTIONS COMPANY, Serial No. 86/757,798 for DENTSPLY SIRONA: THE DENTAL SOLUTIONS COMPANY.

40. And, a few days following on September 21, 2015, Sirona Dental registered the additional marks: Serial No. 86/763,147 for DENTSPLY SIRONA. BETTER DENTISTRY TOGETHER; Serial No. 86/763,171 for DENTSPLY & SIRONA. BETTER DENTISTRY TOGETHER; Serial No. 86/763,213 for DENTSPLY & SIRONA, BETTER TOGETHER; Serial No. 86/763,223 for DENTSPLY SIRONA, BETTER TOGETHER.

41. The Dentsply Sirona combined marks are all currently pending.

42. The day after the merger was announced, the domain name <dentsplysirona.com> was registered in Korea.

43. Upon information and belief, the domain name was either transferred or re-registered on September 22, 2015.

44. According to the publicly accessible service WHOIS, which provides data such as contact information for registered domain holders across multiple registries and registrars, the registrant is listed as only "dentsplysirona.com" with an address in South Korea, 17th fl, Specialty Construction Center, 395-70, Sindaebang-dong, Dongjak-gu, Seoul, KOREA 135-080 KR.

45. Also according to WHOIS, the registrar is listed as Hangang, also of South Korea, with an address at 17th Floor, Specialty Construction Center 395-70 Sindaebang-dong Dongjak-gu Seoul 156-010 South Korea.

46. Plaintiffs have no knowledge of, and have never done business with, the listed registrant "dentsplysirona.com."

47. The domain name <dentsplysirona.com> is confusingly similar to the distinctive and famous marks owned by both Dentsply and Sirona Dental.

48. The domain name is identical to the name of the merged entity, Dentsply Sirona.

49. The mark Dentsply has been in use as a dental trade name for over 100 years and the mark Sirona for over fifty years. The registrant has no legitimate interest in either name.

50. The registrant has never had any prior use of the domain name, commercial or otherwise; indeed, prior to the announcement of the merger of Dentsply and Sirona Dental on September 15, 2015, there would be no reason to use the combined distinctive marks.

51. The registrant has acted in bad faith by listing as its name only the domain name itself.

52. The registrant obtained the registration for the <dentsplysirona.com> domain name, which it had no use of, or conceivable reason to use, one week after the merger of the Dentsply and Sirona Dental and the announcement that the combined company would be called Dentsply Sirona.

53. The above referenced actions are all examples of registrant's bad faith, consistent with 15 U.S.C. §1125(d).

54. The Plaintiffs are experiencing, and will continue to experience, irreparable harm absent an immediate transfer of the domain name <dentsplysirona.com>.



55. The stockholders will be voting on the proposed merger on January 11, 2016. The companies are working to complete the merger as soon as possible, and expect the closing to occur in the first quarter 2016.

56. In order to effectuate the merger and begin operations as a combined multi-billion dollar company, the merged company will need to be able to communicate effectively and provide goods and services to its worldwide network of dental customers.

57. The easiest and most efficient way for a company to communicate to customers worldwide is through its website. The merged entity will be called Dentsply Sirona. The presumptive website for that entity, then, and the one that customers worldwide will seek out, is <dentsplysirona.com>.

58. The Plaintiffs therefore require access to the domain name <dentsplysirona.com> to operate effectively as a multi-billion company.

59. Plaintiffs, their dental support customers, and the public are all being harmed by the bad faith registration of the domain <dentsplysirona.com>.

60. Finally, the purpose of the Lanham Act is to promote the public interest in fair competition, and the Anticybersquatting Act was likewise designed to promote the public good by protecting against bad-faith domain name registrations.

### **COUNT I**

#### **(Anticybersquatting Consumer Protection Act ("ACPA"), 15 U.S.C. § 1125(d)(2) (*In Rem*))**

61. Plaintiff incorporates all of the allegations of paragraphs 1-60 as if the same were fully set forth in this Count I and made a constituent part hereof.

62. Plaintiffs are the owners of distinctive and famous marks, and are the owners of pending marks in the name of their to-be merged company, Dentsply Sirona.

63. The registrant's registration and use of the <dentsplysirona.com> domain name is in bad faith. The domain name is confusingly similar to the registered marks of the Plaintiffs, and identical to the pending combined mark.

64. The registrant's bad faith use of the domain name will cause confusion, and cause users to mistake that website with the Plaintiffs, and is likely to deceive Internet users as to the origin, sponsorship, or approval of the commercial activities of the current domain name registrant.

65. The registrant's use of the domain name is causing immediate and irreparable injury to Plaintiffs and to the goodwill and reputation of the marks and will continue to damage Plaintiffs and the marks unless the Court enjoins such use and transfers registration of the domain name <dentsplysirona.com> back to Plaintiffs.

66. The domain name <dentsplysirona.com> as currently registered to "dentsplysirona.com" violates Plaintiffs' rights as the owner of the Dentsply and Sirona marks, including rights protected under subsections (a) and (c) of 15 U.S.C. § 1125.

67. The registrant has no legitimate rights in the domain name <dentsplysirona.com>.

68. The aforesaid acts and conduct constitute cyberpiracy in violation of the ACPA 15 U.S.C. § 1125(d).

69. Because the registrant is an entity based in South Korea, it is not possible to obtain *in personam* jurisdiction over it, and therefore it is appropriate and required that this Court exercise *in rem* jurisdiction over the domain name <dentsplysirona.com> pursuant to 15 U.S.C. § 1125(d)(2).

70. Plaintiffs have sent notice of the alleged violation and intent to proceed under 15 U.S.C. § 1125(d)(2) to the registrant of the domain name at the postal and email address provided by the registrant to the registrar.

71. Plaintiffs have, and will continue to suffer, irreparable harm absent the transfer of the domain name <dentsplysirona.com> to them and a registrar of their choosing.

72. Plaintiffs have no adequate remedy at law.

**WHEREFORE**, Plaintiff respectfully requests the following:

(a) that the Court issue an Order directing that the <dentsplysirona.com> domain name registration be transferred to Plaintiffs and a registrar of their choosing;

(b) that the Court order the <dentsplysirona.com> domain name to be registered in Plaintiffs' name; and

(c) that, pursuant to 15 U.S.C. § 1125(d)(2)(D)(i), upon receipt of a time-stamped copy of this filed Complaint, the domain name registrar Hangang, the domain name registry Verisign, or other domain authority shall: (I) expeditiously deposit with the Court documents sufficient to establish the Court's control and authority regarding the disposition of the registration and use of the domain name <dentsplysirona.com>; and (II) not transfer, suspend, or otherwise modify the domain name during the pendency of this action, except upon order of the Court.

(d) that the Court grant Plaintiffs such other and further relief as this Court deems is just and proper, including award of injunctive and monetary relief under § 1125(d)(2)(D)(iii).

Date: December 22, 2015

Respectfully submitted,

By: \_\_\_\_\_

  
John D. McGavin (VSB No. 21794)  
jmcgavin@bmhjlaw.com  
BANCROFT, McGAVIN,  
HORVATH, & JUDKINS, PC  
9990 Fairfax Blvd., Suite 400  
Fairfax, VA 22030  
(703) 385-1000

OF COUNSEL:

Steven Lieberman (*pro hac*)  
Sharon Davis (*pro hac*)  
Leo Loughlin (*pro hac*)  
Daniel McCallum (*pro hac*)  
slieberman@rfem.com  
ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
607 14th Street, N.W., Suite 800  
Washington, D.C. 20005  
(202) 783-6040

*Attorneys for Plaintiffs*